

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 28-39 are rejected under 35 U.S.C. 103(a) over Valeo Auto-Electric Wischer Und Motoren GmbH (WO 01/62408).

Claims 40, 42-46, 50-52, 54-58, 62 and 63 are rejected under 35 U.S.C. 103(a) over Reynolds Aluminum (NL 7807040) in view of U.S. patent to Flemmer (5,685,186) or Valeo.

Also, the claims were rejected under 35 U.S.C. 112.

In connection with the Examiner's formal rejection of the claims under 35 U.S.C. 112, applicant has amended claim 52 as suggested by the Examiner, and it is believed that the grounds for this rejection are eliminated.

In other aspects, the claims have been retained as they were.

Turning now to the Examiner's grounds for the rejection of the claims over the art, and in particular over the Valeo reference, it is respectfully submitted that the Valeo reference has a priority date of

February 24, 2000 and it was published on August 30, 2001 while the priority of this application is claimed from April 7, 1999. It is believed that therefore the Valeo reference can not be considered as a valid reference. The rejection of the claims under 35 U.S.C. 103(a) over this reference should also be considered as not tenable and should be withdrawn.

Turning now to the Examiner's rejection of the claims over the Reynolds reference in view of the U.S. patent to Flemmer and Valeo reference, the Reynolds reference teaches to bend alloy rims for bicycles having a constant curvature. It is really not necessary to equip this device with a numerical control unit for controlling the movement of the reverse bending roller. On the other side the Flemmer reference discloses at least two separate bending stations, so that it is not necessary to include the reverse bending roller.

The Examiner proposed to combine the references and indicated that it would be obvious to arrive at the present invention from the combination. Applicants respectfully disagree with this position for the following reasons.

First of all, the references do not contain any hint or suggestion that they can be combinable and should be combinable with one another. As was stated in *ex parte Skinner*, 2 USPQ 2d 1788, 1799 (BPAI 1986):

"When the incentive to combine the teachings of the references is not readily apparent it is a duty of the Examiner to explain why a combination of the reference teachings is proper...absent such reasons or incentives the teachings of the references are not combinable."

In re Fritch, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992) it was stated:

"Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103 teachings of references can be combined only if there is some suggestion or incentive to do so."

Definitely, the references do not contain any suggestions for the combination proposed by the Examiner, and therefore it is believed that the references can not be combinable as a matter of obviousness.

It is also believed that the Examiner's proposed combination of the references is based on a hindsight because the Examiner familiarized himself with the present application. In connection with this, it is also believed to be advisable to cite the decision W. L. Gore & Assocs., Inc. v. Garlock, Inc., 220 USPQ 303, 312-13 (Fed. Cir. 1983), in which it was stated:

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."

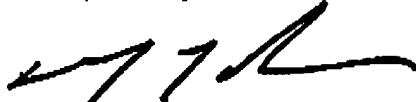
It is therefore believed that the rejection of the claims over the combination of the references should be considered as no longer tenable and should be withdrawn as well.

The claims currently on file should be considered as patentably distinguishing over the art and therefore allowed.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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